UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,497	11/01/2001	Raymond King	10720/2:4	4554

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EXAMINER
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ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	10/016,497	KING ET AL.
	Examiner	Art Unit
	El Hadji M. Sall	2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>01 November 2001</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-126</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-32 and 34-87</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>33 and 88-126</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the application filed on October 25, 2002. Claims 1-

32 and 34-87 are cancelled or withdrawn. Claims 33 and 88-126 are pending. Claims 1-

126 represent domain name acquisition and management system and method.

2.   *Claim Rejections - 35 USC § 102*

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by

another filed in the United States before the invention thereof by the applicant for

patent, or on an international application by another who has fulfilled the requirements

of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof

by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 33 and 88-126 are rejected under 35 U.S.C. 102(e) as being unpatentable over Schneider U.S. 6,895,430.

Schneider teaches the invention as claimed including method and apparatus for integrating resolution services, registration services, and search services (abstract).

As to claims 33 and 124, Schneider teaches a method and a system for domain name management comprising:

Identifying a domain name with a first registration (column 24, line 22);

Identifying an interested party desiring a succeeding registration for the domain name (column 24, line 23-24);

Monitoring a status of the first registration (column 24, lines 45-46; figure 9b); and

Automatically effecting the succeeding registration when the status of the first registration indicates that the domain name is registrable (column 7, lines 26-45; column 24, lines 40-44; figure 9b).

As to claim 88, Schneider teaches a method according to claim 33, further comprising determining an expected expiration data for the first registration (column 24, lines 35-44).

As to claim 89, Schneider teaches a method according to claim 88, further comprising:

Defining a time period for monitoring the status based on the expected expiration date (column 24, lines 35-47); and

Periodically checking the status within the time period (figure 9b).

As to claim 90, Schneider teaches a method according to claim 89, wherein said checking includes checking the status at a predetermined frequency during the time period (column 20, lines 10-19, Schneider discloses providing the option of checking the availability of other domain names).

As to claim 91, Schneider teaches a method according to claim 90, further comprising:

predicting an earliest moment of registrability for the domain name based on the expected expiration data (column 24, lines 34-37); and

Increasing the frequency of said checking, proximate to the predicted earliest moment of registrability (column 20, lines 33-40).

As to claims 95 and 96, Schneider teaches a method according to claim 89, wherein said checking includes receiving a communication pushed from a registrar; and from a registry (column 14, lines 15-21).

As to claims 97 and 98, Schneider teaches a method according to claim 33, wherein: the interested party is a registrant of the domain name; said effecting of the succeeding registration includes requesting a renewal of the registered status of the domain name for the registrant; and registration to an escrow entity, further comprising transferring the registration from the escrow entity to the interested party (column 18, lines 27-52).

As to claims 99 and 100, Schneider teaches a method according to claim 33, wherein said effecting of the succeeding registration includes initiating multiple substantially contemporaneous requests; and the substantially contemporaneous requests are sent to multiple registras (figure 4a; column 16, lines 29-55).

As to claims 101, 102 and 103, Schneider teaches a method according to claims 33, 101 and 102 respectively, wherein the first registration is maintained by a registry, and further comprising: monitoring a request between a registrar and the registry to detect an event affecting the first registration; identifying the event as being of a specific type, based on the specific type of event, taking a predefined action, wherein the specific type of event is a change to a WHOIS record for the first registration; and the predefined action is notifying the interested party of the change (column 7, lines 17-28).

As to claims 107, 108, 109, 110 and 121, Schneider teaches a method according to claims 33, 107 and 120, wherein the succeeding registration is to an escrow agent, and further comprising:

identifying a second interested party (column 24, lines 22-28);

auctioning the succeeding registration between the interested party and the second interested party (column 14, 50-54).

As to claims 117, Schneider teaches a method according to claim 33, wherein the first registration is maintained by a registry, and said effecting of the succeeding registration includes sending an add command to the registry (column 14, lines 15-21; column 18, lines 38-41).

As to claim 118, Schneider teaches a method according to claim 33, wherein the first registration is maintained by a registry and sponsored by a registry and sponsored by a registrar, and further comprising: prior to a purge of the first registration from the registry, re-allocating the domain name to select entity, whereby the domain name is not deleted by the registry (column 14, lines 15-21; column 18, lines 38-41).

As to claim 119, Schneider teaches a method according to claim 118, whrein the selected entity is the interested entity (column 24, line 23-24).

As to claim 120, Schneider teaches a method according to claim 118, wherein the selected entity is an escrow party (column 18, lines 46-48).

As to claim 122, Schneider teaches a method according to claim 121 wherein said auctioning is conducted prior to the first registration entering a "pending delete" status (column 18, lines 53-63).

As to claim 123, Schneider teaches a method according to claim 33, wherein said identifying comprises receiving a back order request for the domain name from the interested party (column 24, lines 22-28)

As to claims 125 and 126, Schneider teaches a system according to claim 124 and 125, wherein:

The domain name is sponsored by a registrar having access to a registry that maintains the first registration (column 14, lines 15-21);

Said means for identifying the domain name includes an input means for receiving an indication of the domain name (column 7, lines 32-36); and

said means for monitoring the status of the first registration includes an acquisition engine coupled to the input means and integrated with the registration includes an acquisition engine coupled to the input means and integrated with the registrar so as to enable the acquisition engine to determine the status of the first registration (column 7, lines 37-45)

4.   *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or

described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a

whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains. Patentability shall not be

negatived by the manner in which the invention was made.

5.   Claims 92, 93 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Schneider U.S. 6,895,430 in view of Green et al. U.S. 6,868,441.

Schneider teaches the invention substantially as claimed including method and

apparatus for integrating resolution services, registration services, and search services

(abstract).

As to claims 92, 93 and 94, Schneider teaches a method according to claim 89.

Schneider fails to teach explicitly said checking includes pinging a registrar; a

substantially contemporaneous pinging of multiple registrars; and pinging a registry.

However, Green teaches said checking includes pinging a registrar; a substantially contemporaneous pinging of multiple registrars; and pinging a registry (column 51, lines 50-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Schneider in view of Green to provide said checking includes pinging a registrar; a substantially contemporaneous pinging of multiple registrars; and pinging a registry. One would be motivated to do so to locate the position of the registrar (column 51, lines 52-54).

6.   Claims 104, 105, 106 and 111-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider U.S. 6,895,430 in view of Hollenbeck et al. U.S. 2005/0102354.

Schneider teaches the invention substantially as claimed including method and apparatus for integrating resolution services, registration services, and search services (abstract).

As to claims 104 and 105, Schneider teaches a method according to claim 102.

Schneider fails to teach explicitly the specific type of event is an RRP event, an RRP delete request, and the predefined action includes notifying the interested party of the RRP event and the requesting a next registration to succeed the first registration subject to the RRP delete request.

However, Hollenbeck teaches shared registration system for registering domain names. Hollenbeck teaches the specific type of event is an RRP event, an RRP delete request, and the predefined action includes notifying the interested party of the RRP event and the requesting a next registration to succeed the first registration subject to the RRP delete request (page 12, [0111]; page 13, [0136]; page 3, [0026] and [0042]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Schneider in view of Hollenbeck to provide the specific type of event is an RRP event, an RRP delete request, and the predefined action includes notifying the interested party of the RRP event and the requesting a next registration to succeed the first registration subject to the RRP delete request. One would be motivated to do so to allow the registry to determine whether the registrar is authorized to perform an action (abstract).

As to claim 106, Schneider teaches a method according to claim 105, wherein the next registration is for the interested party (column 24, lines 22-28).

As to claims 111, 112, 113, 114 and 115, Schneider teaches a method according to claims 33 and 111, wherein the first registration is maintained by a registry

Schneider fails to teach explicitly further determining a deletion time period during which the first registration is expected to delete from the registry; and during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name succeed the first registration.

However, Hollenbeck teaches determining a deletion time period during which the first registration is expected to delete from the registry; and during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name succeed the first registration (page 3, [0042]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Schneider in view of Hollenbeck to provide determining a deletion time period during which the first registration is expected to delete from the registry; and during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name succeed the first registration. One would be motivated to do so to allow updates to domain names registered by the registrar (page 3, [0036]; page 5, [0051]).

As to claim 116, Schneider teaches a method according to claim 115, wherein said obtaining of the list includes querying a registrar database (column 12, lines 53-55; column 3, lines 48-62).

7.   *Citation of Relevant Prior Art*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art: 6,880,007; 6,745,248; 2002/0103820; 2002/0129013 and 2002/0010795 are considered pertinent to applicant's disclosure. Prior art

2002/0103820 could be used for 102 rejection. Prior art 6,880,007; 6,745,248;

2002/0129013 and 2002/0010795could be used for 103 rejection.

8.   *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to El Hadji M Sall whose telephone number is 571-272-

4010. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

El Hadji Sall
Patent Examiner
Art Unit: 2157

ARIO ETIENNE
PRIMARY EXAMINER